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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,702	03/29/2004	James Nicholas	Nicholas Case 1	1364
7590	10/16/2006		EXAMINER	
Edward M. Fink, Esq. 51 Jamaica Street Edison, NJ 08820			HOWELL, DANIEL W	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/811,702

Applicant(s)

NICHOLAS, JAMES

Examiner

Daniel W. Howell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8-7-06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green (3849019) in view of Voissem (3266346). Green shows an annular cutter 20 having a plug ejector. The ejector has a washer 14, pins 16, 18, which extend through holes 28, 30, in the base of the cutter, and springs 32, 34, for retracting the ejector. When the tool is removed from the chuck, the ejector is likely to separate from shank 10 (due to the bias of the springs), possibly becoming lost after the separation. Further, the unsecured fronts of the pins may become canted within the holes over time, causing binding as the move in the base of the cutter. Voissem shows a similar ejector having a rear plate 64, a forward plate 62, and bolts interconnecting the two plates. It is considered to have been obvious to have provided Green with a forward plate/washer secured with bolts as taught by Voissem in order to prevent accidental loss of the ejector and guide the rods such that they slide smoothly within the holes of the base of the cutter. Voissem and Green do not seem to explicitly state what the materials of the washers/plates are. It is considered to have been obvious to have experimented and made the washers of materials such as metal or wood, due to their qualities such as low cost and durability.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frevel (2435648) in view of Hougen (3559513). Frevel shows a hole saw having blades 12 in a circular arrangement on base 11 and an ejector. The ejector has a forward washer 14, a rearward washer 18, bolts 16 connecting the two washers, and a spring 19 for retracting the ejector. It's a bit of a

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stretch to call the teeth 12 of Frevel a “circular blade” as set forth in present claim 1.

Nevertheless, figure 17 of Hougen shows an ejector 126 biased forwardly within circular blade 20 by spring 130. The cutter of Hougen has numerous teeth 32, which spreads the wear of the cutting operation across many more teeth, providing a long lasting cutter. It is considered to have been obvious to have replaced the toothed/bladed cutter of Frevel with an annular hole cutter as shown by Hougen in order to spread the wear of the cutting operation over a larger number of cutting teeth. Frevel and Hougen do not seem to explicitly state what the materials of the washers/plates are. It is considered to have been obvious to have experimented and made the washers of materials such as metal or wood, due to their qualities such as low cost and durability.

4. Applicant's arguments filed August 7, 2006, have been fully considered but they are not persuasive. Applicant first argues that Green is for cutting on porcelain, and that the device being claimed is solely designed for generation of holes in wooden structures. It is initially noted that nothing in the claims is directed toward cutting solely in wood. Claim 1 begins, “Hole saw structure including.....,” such that a cutter which operates on any type of workpiece will read on this claim. Applicant also argues that Green does not disclose any structure or means for expelling unwanted material. Green is clearly capable of cutting completely through a workpiece, and the washer 14 and pins 16, 18, will clearly operate as an ejector. On page 4 of the response, the operation of Voissem is discussed, but this discussion isn't particularly tied in to the obviousness rejection. As discussed in the rejection, when Green is removed from the chuck, there is a likelihood that the spring will separate the cutter 20 and washer 14. Providing the plate/washer system as shown by Voissem will prevent this separation and loss.

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Regarding the rejection of Frevel in view of Hougen, Applicant argues that Frevel uses a weighted hub to strike against the disk 24d to remove the disk from the cutter, and states that this manual removal of the disk (by moving weight 20a) is different than the mechanical removal of Applicant's device. Close reading of claim 1 will show that those items of discussion simply aren't present in Applicant's claims. That is, nothing in claim 1 provides for removal of a cut disk solely by mechanical means. The claim is written broadly enough that the ejector of Frevel meets all of the limitations of present claim 1.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Monica Carter, may be reached at 571-272-4475.

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In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.

A handwritten signature in cursive script, appearing to read 'Howell', is positioned above the printed name.

Daniel W. Howell  
Primary Examiner  
Art Unit 3722